

REMARKS

The Office Action dated November 18, 2005, has been received and carefully considered. Reconsideration of the outstanding objections/rejections in the present application is respectfully requested based on the following remarks.

I. THE ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the indication in the Office Action that claims 83-88 are allowed. Applicants note with equal appreciation the indication in the Office Action that claims 7, 10, 11, 15-20, 22, 24, 25, 30, 33-35, 37-42, 47, 49, 53, 55, 63, 65, 73, 74, 77, 78, and 80-82 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, Applicants have opted to defer rewriting the above-identified claims in independent form pending consideration of the arguments presented below with respect to the rejected claims.

II. THE ANTICIPATION REJECTION OF CLAIMS 1-6, 8, 9, 12-14, 21, 23, 26-29, 31, 32, 36, 43-46, 48, 50-52, 54, 56-62, 64, 66-72, 75, 76, AND 79

In the Office Action, claims 1-6, 8, 9, 12-14, 21, 23, 26-29, 31, 32, 36, 43-46, 48, 50-52, 54, 56-62, 64, 66-72, 75, 76, and 79 were rejected under 35 U.S.C. § 102(b) as being

anticipated by Benes et al. (U.S. Patent No. 5,225,089). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id.. "In addition, the prior art reference must be enabling." Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention." Id..

Regarding claim 1, the Examiner asserts that Benes et al. teaches an acoustic agglomerator for agglomerating constituents comprising an acoustic generator configured to communicate with an area containing a fluid having constituents, wherein the acoustic generator is operable to generate a frequency modulated acoustic field without reliance on the fluid, wherein the

frequency modulated acoustic field is applied to the fluid to enhance agglomeration of the constituents in the fluid, as claimed. However, it is respectfully submitted that Benes et al. fails to teach, or even suggest, agglomerating constituents in a fluid or in any other manner. Totally in contrast, Benes et al. teaches separating particles, which is obviously different than agglomerating, or combining, particles, as claimed. Indeed, it is respectfully submitted that Benes et al. teaches away from the claimed invention as set forth in claim 1. As stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Thus, it is respectfully submitted that Benes et al. does not teach, or even suggest, the claimed invention as set forth in claim 1. Accordingly, it is respectfully submitted that claim 1 should be allowable in view of Benes et al.

Claims 2-6, 8, 9, and 12-14 are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-6, 8, 9, and 12-14 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features

which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding claims 21, 43, 52, 59, and 66, the same arguments presented above with respect to claim 1 are applicable. That is, it is respectfully submitted that Benes et al. does not teach, or even suggest, the presently claimed invention as set forth in claims 21, 43, 52, 59, and 66. Accordingly, it is respectfully submitted that claims 21, 43, 52, 59, and 66 should be allowable in view of Benes et al.

Claims 23, 26-29, 31, 32, 36, 44-46, 48, 50-51, 54, 56-58, 60-62, 64, 67-72, 75, 76, and 79 are dependent upon independent claims 21, 43, 52, 59, and 66. Thus, since independent claims 21, 43, 52, 59, and 66 should be allowable as discussed above, claims 23, 26-29, 31, 32, 36, 44-46, 48, 50-51, 54, 56-58, 60-62, 64, 67-72, 75, 76, and 79 should also be allowable at least by virtue of their dependency on independent claims 21, 43, 52, 59, and 66. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-6, 8, 9, 12-14, 21, 23, 26-29, 31, 32, 36, 43-46, 48, 50-52, 54, 56-62, 64, 66-72, 75, 76, and 79 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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